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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,138	10/27/2003	Lee C. Moore	D/A2471	3243
41030 7590 02/17/2009 Xerox Corporation c/o ORTIZ & LOPEZ, PLLC P. O. BOX 4484 ALBUQUERQUE, NM 87196-4484				
EXAMINER MCCORMICK, GABRIELLE A				
ART UNIT 3629		PAPER NUMBER		
MAIL DATE 02/17/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/694,138

**Applicant(s)**

MOORE, LEE C.

**Examiner**

Gabrielle McCormick

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. This action is in reply to the amendment filed on October 26, 2008.
2. Claims 1-3, 6-7, 10-16 and 18 have been amended.
3. Claims 1-20 are currently pending and have been examined.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundgren (US Pub. No. 2003/0048471) in view of Marsh (US Pub. No. 2002/0061238) in view of Ross (US Pat. No. 5,465,213).
6. **Claims 1, 3-11 and 13-20:** Lundgren discloses providing aircraft passengers (i.e., travelers) with Internet access (para. [0003]) whereby a "laptop computer or handheld computer" is connected "to an Internet web site for accessing a printing management application" where printing is performed "at a designated airport or at other locations designated by the user." (para. [0007]). When selecting the printing and delivery options, including printing to printers at airports, the traveler is able to electronically select production facilities near the traveler's destination. (para. [0018]). The document is printed at the location specified by the traveler and is picked up "at the airport after the aircraft has landed." (para. [0020]), thus the document is distributed to a pick-up facility as chosen by the traveler, wherein the destination is an *en-route stop*. (Any airport is considered an *en-route stop* as the document is picked up after landing.) Lundgren discloses that

documents can be reviewed from the Internet (para. [0004]). In this regard, it is obvious that documents that are reviewed from the Internet include previously published works, i.e., *publications*. Therefore, publications are ordered from the Internet when the traveler provides user ID and billing information to the printing services application (para. [0018]). Lundgren further discloses requiring "user identification (ID) and account information, including billing information such as a credit card number" be provided to the printing services application. This information is used to "track any print job initiated through the printing services application." (para. [0018]). It is obvious that upon pick-up of the selection, the traveler's identity would be authenticated in that the print order would be matched against the user ID and the billing information provided by the traveler when the selection was ordered. A remote pick-up location would be motivated to verify customer IDs and account information to ensure that print orders are released to the customer who ordered it. By teaching a system where on-board and remote printing operations of documents on the Internet (P[0004]) are performed for a fee, printing on demand is performed.

7. Lundgren does not disclose *a catalog from which publications can be selected* or that the print on demand system prints a publication cover and binds the publication block of the selection from the catalog. Lundgren does disclose Internet access during a flight where travelers can access Internet services. This disclosure of Internet access during a flight obviously includes access to web based businesses. Lundgren discloses picking up the printed document "at the airport after the aircraft has landed" (P[0020]), but does not explicitly disclose a store, vending machine, kiosk, or location near the arrival gate.
8. Marsh discloses an online system for ordering and printing books on demand in which customers access via the Internet to view the books in the digital library (i.e., preview the books in a catalog or database), select and order the book and command the book to be printed, bound and trimmed. (P[0112]). This act of accessing a catalog over the internet while traveling (i.e., the combination of Marsh's catalog with Lundgren in-flight internet access via a laptop) discloses the limitation of *wherein the catalog is located on-board a vessel*. Marsh also points to US Pat. No.

5,465,213 (Ross) as providing the teaching for accessing via the Internet to order a book to be printed on demand. (P[0112]).

9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included selecting and previewing publications to be printed from an online catalog, as disclosed by Marsh in the system disclosed by Lundgren, for the motivation of providing a convenient means of shopping. Catalogs are an old and well known form of perusing items available for purchase that affords the customer convenience. By having provided Internet access to airline passengers, Lundgren foresaw the use of Internet shopping, and therefore, the obvious need for catalogs (Lundgren; para. [0003]: the system offers "Internet services while in-flight"). Therefore, ordering anything from the Internet, including books to be printed on demand, is an obvious expansion of Lundgren's system.
10. Furthermore, the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.
11. Ross discloses a kiosk based system where a customer views "promotional sales information" (i.e., a catalog), purchases the book through system which initiates printing of the book and cover and finally binding. (C1; L55 – C2; L32). Ross discloses that the "floor space required for the book manufacturing system...is somewhat larger than an ordinary office desk..." (C2; L57-59). Ross also discloses using a WAN for a user to select a book where the WAN includes "satellite communications". (C12; L38-56). Ross further discloses both a kiosk and a store (C1; L63-C2; L15).
12. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have expanded the system of Lundgren to include the print on demand system of Ross/Marsh wherein a book is ordered via the Internet and printed and bound with a cover and picked-up at a store or kiosk since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one

of ordinary skill in the art would have recognized that the results of the combination were predictable.

13. Specifically, it is predictable that the system of Lundgren, which discloses ordering and purchasing printed documents, when expanded to include the automatic thermal binding machine which is used to bind the text pages into the cover (Ross; C2; L27-29), would still perform the function of printing ordered documents. As the floor space requirements for the entire book manufacturing system of Ross is "somewhat larger than an ordinary office desk", it is obvious that the system of Lundgren would be capable of the expansion to include the added binding machine. It is also both obvious and predictable that the document printed using Lundgren's system and available to be picked up at the airport would consist of a store.
14. **Claim 2:** Lundgren/Marsh/Ross does not explicitly disclose that *the catalog is made available in printed form*, however, The Examiner takes **Official Notice** that airlines provide in-flight catalogs, (i.e., *wherein the catalog is located on-board a vessel*) such as "SkyMall", therefore it is obvious to expand the combined system of Lundgren/Marsh/Ross to include a printed catalog. One would be motivated to do so in order to minimize both the cost of the in-flight Internet access and the use of the laptop battery. By providing a printed catalog, the traveler is able to leisurely peruse the selections available then connect to the Internet just to make the purchase.
15. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lundgren (US Pub. No. 2003/0048471) in view of Marsh (US Pub. No. 2002/0061238) in view of Ross (US Pat. No. 5,465,213) in further view of PR Newswire ("iUniverse Secures Additional \$18 Million in Funding". PR Newswire. New York: Oct. 15, 2001. pg. 1).
16. **Claim 12:** Lundgren/Marsh/Ross disclose previewing and selecting, but do not disclose that the publication includes *only selected chapters of a book or several publications in a single, bound publication*.

17. PR Newswire, however, discloses customs book programs that allow customers to "browse, compile and purchase books compiled from individual chapters of selected Microsoft, Frommer's, Cliff Notes and Dummies Guide titles." (pg. 1; para. 3).
18. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included selecting chapters to create a custom book, as disclosed by PR Newswire, in the system of Lundgren/Ross/Marsh for the motivation of providing content that suits a customer's specific needs. It is obvious to order the printing of selected chapters, such as from a travel book (such as Frommer's) in order to minimize the amount of printed pages that a traveler carries. The traveler of Lundgren's system would be motivated to print out only the material (i.e., the chapters of a travel guide) that pertains to the sites, hotels, or restaurants of interest to him. The option to print only the selected chapters provides concise and pertinent information without creating the burden of carrying too much information.

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 1-20 have been considered but are not persuasive.
20. With regard to claims 13 and 18, limitations recited in the preamble are not given patentable weight. Further, the patentability of an apparatus (the system of claim 18) depends on claimed structure, not on use or purpose of that structure.
21. Applicant argues that Lundgren does not disclose a print on demand system as disclosed in P[0003] of Applicant's specification. This results in arguing the application of the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
22. Applicant argues that Lundgren does not disclose print on demand because the publication printed in Lundgren's system does not include a book cover and book block. The Examiner notes that the claims only recite binding of the publication and a publication cover. The claims do not limit the invention to a book. The Examiner cited Ross to provide the teaching for print on

demand of publications (books, in the case of Ross) where the publication is bound and covered. Thus, the combination of Lundgren and Ross disclosed en-route ordering of print on demand publications that are covered and bound.

23. The Applicant argues that Lundgren does not mention internet shopping. Though Lundgren does not explicitly mention internet shopping, Lundgren does disclose the use of the Internet by passengers for "reviewing web pages, gathering information, creating documents, and performing other work or leisure related activities." (P[0002]). One of ordinary skill in the art would have recognized that Internet shopping involves reviewing web pages, gathering information and can be either a work or leisure related activity, therefore the Examiner maintains that Lundgren foresaw Internet shopping and the combination with Marsh is appropriate.
24. The Applicant's argument that "SkyMall" catalogs do not include the capability of purchasing items in flight and picking them up at the destination is not persuasive. "SkyMall" was cited as merely an old and well known example of printed catalogs that exist on airplanes and was not used to disclose anything further.
25. Applicant's argument with respect to the combination of Lundgren, Marsh and Ross is not persuasive.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629